

# Notice of Allowability

Application No.

09/832,541

Examiner

Taylor Victor Oh

Applicant(s)

MORGENSTERN ET AL.

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 9/2/04.
2. ☒ The allowed claim(s) is/are 1-76 and 93-101, as renumbered in claims 1-85.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
  - \* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 9/2/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),  
Paper No./Mail Date 9/27/04
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

*Chula Tsang*

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 9/2/04 has been entered.

**The Status of Claims:**

Claims 1-76 and 93-101 are pending.

Claims 77-92 have been canceled.

Claims 1-76 and 93-101 have been allowed.

**Examiner's Amendment and Reasons of Allowance**

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with an attorney of record, Mr. Richard A. Schuth on 9/27/2004 .

I. The application has been amended as follows:

Claims 77-92 have been canceled.

In claim 37, line 2 on page 7 (Amendment B on 9/02/04):

The term "--substantially --" before the word "homogeneous" has been deleted .

In claim 67, line 2 on page 7 (Amendment B on 9/02/04):

The term "--substantially --" before the word "homogeneous" has been deleted .

II. The following is an examiner's statement of reasons for allowance:

- The rejection of Claims 1 and 93 under 35 U.S.C. 112, first paragraph, has been withdrawn due to applicants' convincing arguments;
- The rejection of Claims 11, 17-18, 30-31, 34, 46-47, 54, 74-75, and 100-101 under 35 U.S.C. 112, second paragraph, has been withdrawn due to applicants' convincing arguments;

- The close references for the current invention are Yamauchi et al (EP0734765) and Franczyk et al (U.S. 5,739,390).

Yamauchi et al teaches a method for dehydrogenating an alcohol by using the modified Raney catalyst alloy power containing copper without any support system.

Franczyk et al teaches a process to prepare amino carboxylic acid salts, such as the salts of glycine, iminodiacetic acid, N-methylglycine by contacting amino alcohols, such as monoethanolamine or diethanolamine with an alkali metal hydroxide in the presence of a copper catalyst containing alkali-resistant carriers. Furthermore, the process can be involved in phosphonomethylating the carboxylic acid salt to form N-(phosphonomethyl)iminodiacetic acid or a salt, which further can be converted to N-(phosphonomethyl)glycine or a salt.

The instant invention, however, differs from the prior art in that the copper catalyst comprises a metal sponge supporting structure having at least 2 to 30 % by weight copper metal resistant to deformation under conditions of the dehydrogenation. In addition, unless all limitations of the claims are met, there is no prior art rejection. See In re Zurko 59 USPQ 2d 1690 (Fed Cir. 1991) and In re Lee, 61 USPQ 1430 (Fed Cir. 1991).

Therefore, the claimed invention would not have been obvious to the person with an ordinary skill in the art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning the communication after allowance such as sending all post-allowance correspondence should be directed to "Box Issue Fee" or faxed directly to PUBS at 703-305-8755. This will expedite the process of these papers.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Yang*  
9/27/04

*Cecilia Tsang*